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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

MEDIATEK INC.	**Civil Action No. 4:11-cv-05341 (YGR)**
Plaintiff,	
v.	**MEDIATEK INC.'S REPLY IN SUPPORT OF ITS MOTION TO STRIKE, OR IN THE ALTERNATIVE PRECLUDE UNDER *DAUBERT*, IMPROPER OPINIONS OF DR. FRANK VAHID**
FREESCALE SEMICONDUCTOR, INC.	
Defendant.	
	Hon. Yvonne Gonzalez Rogers
	Hearing Date: December 10, 2013
	Time: 2:00 p.m.
	Courtroom: 5
	DEMAND FOR JURY TRIAL

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I.   INTRODUCTION

Freescale's opposition fundamentally confuses two different concepts: (1) applying the plain and ordinary meaning of a claim term; and (2) performing a claim construction analysis to construe a term. When a term's plain and ordinary meaning is obvious on its face, the parties and their experts are to merely apply this meaning in their infringement and invalidity analyses without attributing additional definition(s) to the term. If a party believes that a claim term requires a special meaning not obvious on its face, however, the party must propose that term for construction by the Court. The Court then decides how to instruct the jury on the term's special meaning based upon the claim language, specification's disclosure, any relevant prosecution history, and potentially extrinsic evidence. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1314-18 (Fed. Cir. 2005). In this District, this process is defined by Patent L.R. 4, which sets forth deadlines for the parties to identify disputed terms, disclose respective construction, and present briefing and oral argument to the Court.

Freescale attempts to circumvent these rules through the expert report of Dr. Frank Vahid. Time and again, Dr. Vahid offers opinions purporting to construe claim terms to give them unique and narrow definitions. Freescale would offer these opinions to the jury despite its having disclosed ***none*** of Dr. Vahid's new constructions under Patent L.R. 4 (or indeed at any time during fact discovery). And Dr. Vahid's surprise constructions are, by his own admission, a departure from the plain and ordinary meaning. To give but one example, Dr. Vahid admits that the plain and ordinary meaning of the term "at least one address bus" recited in claim 2 of U.S. Patent No. 6,088,753 (the "'753 patent") includes one ***or more*** address busses. (Dkt. No. 299-15 (hereinafter "Vahid Opening Report") at ¶ 59.) Despite this plain meaning, Dr. Vahid engages in claim construction analysis that purports to narrow "at least one address bus" to mean ***only*** one address bus, based on an embodiment he says is disclosed in the specification. (Dkt. No. 299-12 – 299-14 (hereinafter "Vahid Rebuttal Report") at ¶¶ 29-43.) This is improper. Freescale should not be permitted to ambush MediaTek with surprise claim constructions disclosed only after the close of fact discovery in violation of Patent L.R. 4 and created for the purpose of inventing meritless non-infringement positions.

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1   Freescale's attempts to justify Dr. Vahid's new constructions have no merit. Freescale

2 argues that, because Dr. Vahid parrots that he "applied the meaning to the term as it would have

3 been understood by a person of ordinary skill in the art" (Dkt. No. 320 (hereinafter "Freescale

4 Opp." at 12), there is no claim construction going on. Freescale is wrong. Even a passing look

5 behind this gloss reveals Dr. Vahid to be importing limitations from the specification, restricting

6 claims based on purported prosecution history or prior art references, and otherwise construing

7 terms so narrowly that they bear no resemblance to their plain and ordinary meaning. (*See* Dkt.

8 No. 299-5 (hereinafter "MediaTek Mot.") at 21-25.) Because all of the documents Dr. Vahid

9 cites for his new and narrowing constructions were known to Freescale before the first Patent

10 L.R. 4 deadline (June 29, 2012), moreover, there is no justification for Freescale's failure to

11 timely disclose these constructions. (Dkt. No. 37 at 7.)

12   Freescale falsely compares Dr. Vahid's reports with those of MediaTek's experts.

13 (Freescale Opp. at 13-15.) Tellingly, however, Freescale is unable to cite even a ***single*** example

14 where MediaTek's experts limit claim terms based on the specification, prosecution history, or

15 purported prior art, or otherwise engage in claim construction analysis. MediaTek's experts have

16 not done so. Instead, they consistently (and simply) apply the plain and ordinary meaning of the

17 claim terms (without further definition).

18   Arguing that Dr. Vahid should be permitted to apply his own meaning of terms

19 (Freescale Opp. at 3-5), Freescale confuses the roles of the Court and jury. The Court instructs

20 the jury on the meaning of claim terms, including in the case of terms with an obvious plain

21 meaning the instruction to apply the term's ordinary meaning without further definition. The

22 jury then applies the definitions the Court provides. Dr. Vahid's report, however, does not

23 merely purport to assist the jury in applying claim terms to accused products. Dr. Vahid's seeks

24 to argue to the jury what claim terms mean. In at least one instance, Dr. Vahid even directly

25 contradicts the Court's construction. (*Compare* Dkt. No. 127 (Claim Construction Order) at 21

26 *with* Vahid Rebuttal Report at ¶ 46.) This violates black letter law. *See CytoLogix Corp. v.*

27 *Ventana Med. Sys., Inc.*, 424 F.3d 1168, 1172 (Fed. Cir. 2005) ("[E]xpert witnesses [] testified

28 before the jury regarding claim construction, and counsel argued conflicting claim constructions

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1 to the jury. This was improper, and the district court should have refused to allow such

2 testimony."); *see also Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995)

3 *aff'd*, 517 U.S. 370 (1996).

4   Finally, despite acknowledging that the Court has completed its claim construction

5 process, and despite the inconsistency with its argument that no claim construction is going on,

6 Freescale all but admits that Dr. Vahid's report is Freescale's bid to seek another bite at the claim

7 construction apple. (*See* Freescale Opp. at 16-17.) But with the discovery period closed and trial

8 scheduled to begin in February, the time for new claim constructions has long since passed.

9   For these reasons, and those set forth more fully in MediaTek's opening brief and below,

10 Dr. Vahid's new constructions and his opinions based on these constructions should be stricken.

11 **II.**   **ARGUMENT**

12   **A.**   **Federal Circuit Law Differentiates Between Applying Plain and Ordinary Claim Language, And Construing A Claim Term**

13

14   Contrary to Freescale's tortured explanation of the law, the Federal Circuit and lower

15 courts differentiate between: (1) applying the ordinary and customary meaning of a claim term;

16 and (2) construing a claim term. A claim term that has a readily apparent plain meaning does not

17 require construction. *See ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312,

18 1325–26 (Fed.Cir.2012) (holding a district court did not err in declining to construe claim terms

19 upon concluding the terms had plain meanings that did not require additional construction).

20 Applying the ordinary and customary meaning of a term simply requires using the meaning that

21 the term would have to a person of ordinary skill in the art at the time of the invention—*i.e.*

22 applying the widely accepted meaning of commonly understood words. *See Phillips*, 415 F.3d at

23 1313 ("[T]he ordinary and customary meaning of a claim term is the meaning that the term

24 would have to a person of ordinary skill in the art in question at the time of the invention."); *id.*

25 at 1314 (Where claim language has an ordinary meaning that is "readily apparent even to lay

26 judges," claim construction "involves little more than the application of the widely accepted

27 meaning of commonly understood words."); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*,

28 334 F.3d 1294, 1298 (Fed. Cir. 2003) ("In the absence of an express intent to impart a novel

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1 meaning to the claim terms, the words are presumed to take on the ordinary and customary

2 meanings attributed to them by those of ordinary skill in the art."); *Applied Signal Tech., Inc. v.*

3 *Emerging Markets Commc'ns, Inc.,* C-09-2180-SBA, 2011 WL 500786, at * 17 (N.D. Cal. Feb.

4 9, 2011) ("Court finds that the plain and ordinary meaning of the term [] applies, and this claim

5 term requires no further construction."); *CardioNet, Inc. v. Mednet Healthcare Technologies,*

6 *Inc*., CIV.A. 12-2517, 2013 WL 6047565, at *1 (E.D. Pa. Nov. 15, 2013) ("A claim term that has

7 a readily apparent plain meaning may not require construction."). No further definition of the

8 term is appropriate.

9   Freescale, through its expert Dr. Vahid, now attempts a second bite at the claim

10 construction apple, proposing "novel meanings" that are neither "readily apparent" nor "widely

11 accepted meaning[s] of commonly understood words." *Phillips*, 415 F.3d at 1313; *Brookhill-*

12 *Wilk*, 334 F.3d at 1298. Freescale's claim that Dr. Vahid is simply applying, rather than

13 attempting to construe, the nine claim terms raised in MediaTek's motion is belied by Dr.

14 Vahid's detailed claim construction analysis, complete with its examination of the specification,

15 analysis of the prosecution history, reliance on inventor testimony, and evaluation of prior art

16 before the PTO.[1] These inquiries are tell-tale signs that claim construction is going on.

17   It is black letter law dating from *Markman* itself that parties are not permitted to argue

18 claim construction to the jury. (MediaTek Mot. at 18 (cited cases therein).) Despite this law,

19 Freescale argues that Dr. Vahid should be allowed to proffer his claim construction opinions to

20 the jury, interpreting intrinsic evidence and opining as to terms' special meaning. (Freescale

21 Opp. at 1-5.) Freescale fails to cites a single case that supports such a radical departure. There is

22 no indication in the cases Freescale does cite of an expert testifying that a claim term should be

23 defined in a specific way. Nor does Freescale identify a single case where an expert was

24 permitted to promote a special construction to the jury interpreting a patent's specification, file

25 history, or cited prior art. Instead, in every case Freescale cites, the expert simply applied the

26

27

28 [1] MediaTek's Motion originally identified ten terms. However, Freescale has agreed to withdraw Paragraphs 85-93 of Dr. Vahid's Opening Report, thereby dropping its new construction of the term "arbitration unit." (Freescale Opp. at 1, n 1.)

1 court's construction or else applied the plain and ordinary meaning of the terms (without further

2 definition).

3   Thus, in *Cordis Corp. v. Medtronic Ave, Inc.*, the parties' experts merely applied the

4 Court's "wall thickness" construction to the accused product. 511 F.3d 1157, 1181 (Fed. Cir.

5 2008). In *Broadcom Corp. v. Qualcomm Inc.*, the Federal Circuit observed with approval that

6 "[t]he term 'selectively couples' was not construed by the district court because the parties

7 agreed to let the ordinary meaning control," and "Broadcom has not argued for a new claim

8 interpretation…." 543 F.3d 683, 696 (Fed. Cir. 2008). *Carnegie Mellon Univ. v. Marvell Tech.*

9 *Group, Ltd.* stands for the unremarkable proposition that, "[a]lthough claims construction is a

10 question for the Court, not the jury, to decide, the application of claims language to the

11 determination of infringement is a question of fact for the jury." 2012 U.S. Dist. LEXIS 159796,

12 at * 5 (W.D. Pa. Nov. 7, 2012). And *Plew v. Ltd. Brands, Inc.,* cited by Freescale, actually

13 refutes Freescale's argument: holding that experts are supposed to "apply[] the court's

14 construction of the claim term to the accused product…; experts ***do not*** look to intrinsic

15 evidence." 2012 U.S. Dist. LEXIS 14966, at *9 (S.D.N.Y. Feb. 6, 2012) (emphasis added).

16   Freescale relies on the discussion of the claim term "crystalline content" in *Biotec*

17 *Biologische Naturverpackungen GmbH & Co. KG v. Biocorp, Inc.*, 249 F.3d 1341, 1348 (Fed.

18 Cir. 2001), to argue that experts may opine on the "interpretive gaps between a court's claim

19 constructions and the accused products or prior art." (*See* Freescale Opp. at 4.) Freescale is

20 mistaken. In *Biotec,* the district court construed the "crystalline content" term during the normal

21 claim construction process. At trial, both sides offered competing expert testimony applying the

22 court's construction. The parties disputed "which peaks in the x-ray diffraction plots of the

23 [accused] product should be counted as representing crystalline content [as construed by the

24 court]" *Biotec*, 249 F.3d at 1348. This was a dispute about the facts of the accused product, not

25 about the meaning of a claim term. There is no suggestion in *Biotec* that experts were permitted

26 to argue to the jury that intrinsic evidence required giving some special or different meaning to

27 the "crystalline content" term. *Id*. Here, by contrast, Dr. Vahid does not simply opine as to the

28 technical function and operation of the accused products. Instead, as detailed in MediaTek's

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opening brief, Dr. Vahid purports to offer his own construction of claim terms to the jury –

constructions that depart from the terms' plain and ordinary meanings. (MediaTek Mot. at 3-16.)

Freescale's attempts to distinguish the cases MediaTek cites also fail. For example,

Freescale substantively misstates the court's decision in *CytoLogix Corp. v. Ventana Med. Sys.*,

Inc., 424 F.3d 1168 (Fed. Cir. 2005). Freescale argues that *CytoLogix* "is irrelevant to whether

the Court should allow the proposed testimony of both parties' experts on such plain and

ordinary meaning" (Freescale Opp. at 17.) But *CytoLogix* precludes Dr. Vahid's attempt to

argue to the jury, based on intrinsic evidence, what the special meanings of claim terms should

be. *CytoLogix* found that permitting the parties to "present[] expert witnesses who testified

before the jury regarding claim construction, and counsel [to] argue[] conflicting claim

constructions to the jury. . . was improper, and the district court should have refused to allow

such testimony despite the agreement of the parties…" *Id.* at 1172. *CytoLogix* is thus on point,

and prohibits Dr. Vahid's proposed testimony—particularly where Freescale seeks to introduce

its new constructions more than a year after the Court conducted its *Markman* hearing.

Finally, Freescale attempts to distinguish *Apple, Inc. v. Samsung Electronics Co., Ltd.*,

11-CV-01846-LHK, 2012 WL 2571332, at *3 (N.D. Cal. June 30, 2012), on the basis that

Apple's expert's credentials were challenged. (Freescale Opp. at 19.) In fact, the court did not

exclude this expert's testimony based on his lack of credentials. Instead, the testimony was

excluded because it went to the legal question of patent scope, and "[t]o the extent the jury needs

additional expert guidance about issues of patent scope, it is an issue for claim construction,

appropriately addressed by the Court." *Apple,* 2012 WL 2571332, at *3.

Because Dr. Vahid's proposed claim construction testimony is prohibited by law, it

should be stricken.

B.   Dr. Vahid's Opinions Seek to Construe the Claim Terms Rather Than Apply the Plain and Ordinary Meaning or the Court's Constructions

Freescale relies on the following self-serving statement from Dr. Vahid's report to argue

that Dr. Vahid is not engaged in claim construction: "For the claim terms defined by the court or

agreed upon by the parties, I have used that meaning. For the other claim terms, I have applied

the meaning to the term as it would have been understood by a person of ordinary skill in the art around the time the patent was filed." (Freescale Opp. at 12 (citing Vahid Rebuttal Report at ¶ 10).) Having made this statement, however, Dr. Vahid proceeds to repeatedly breach it.

As discussed in MediaTek's opening brief, Dr. Vahid does *not* apply the plain and ordinary meaning of the terms at issue. Instead, he provides his own narrow constructions for the terms based on his reading of the specification, file history, and even extrinsic evidence, and then applies his newly-minted constructions to the accused products (or prior art). (*See, e.g.*, Freescale Opp. at 6 (relying on the Court's construction of "predetermined" from a ***different patent*** to construe "interconnecting a plurality of components . . . in a predetermined way"), 8-9 (pointing to disclosures in the patent specification to define "information indicating a clock frequency requirement"), 24-25 (considering prior art cited during prosecution to define "at least one address bus").) Dr. Vahid's numerous and previously-undisclosed constructions, as well as the invalidity and non-infringement opinions based on these ambush constructions, should be stricken. (MediaTek Mot. at 3-17.)

1. "at least one address bus" ('753 patent, claim 2)

With respect to the term "at least one address bus," rather than apply the "widely accepted meaning of commonly understood words" (*Phillips*, 415 F.3d at 1314), Dr. Vahid uses seven pages of his report to argue for his own narrowing construction of the term. (Vahid Rebuttal Report ¶¶ 30-43.) The plain language of claim 2 of the '753 patent recites "at least one address bus and at least first and second data busses." If Dr. Vahid were applying the plain meaning of "at least one" (i.e., "one or more") as Freescale argues, then Dr. Vahid would have to agree that claim 2 covers a bus arrangement with two addresses buses and two data buses. Freescale mischaracterizes its own expert's opinion on this term by arguing that Dr. Vahid addresses implementations that feature two or more address busses. (Freescale Opp. at 21). But in the very same paragraphs Freescale cites, Dr. Vahid opines that the claim requires use of "a ***single*** address bus and two data buses." (*See, e.g.*, Vahid Rebuttal Report at ¶ 37.) Dr. Vahid's report, in other words, demonstrates the fallacy of Freescale's argument.

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1   After first claiming Dr. Vahid is applying the plain meaning of "at least one" (Freescale

2 Opp. at 21), Freescale proceeds to contradict itself by admitting that Dr. Vahid has construed this

3 term based on the Okazawa reference and the prosecution history. (Freescale Opp. at 24-25.)

4 The cases Freescale cites in its attempt to justify Dr. Vahid's new construction demonstrate that

5 Freescale misunderstands the difference between a *Markman* hearing and an infringement trial.

6 All three of Freescale's cited cases address experts offering their opinions to the court in a claim

7 construction hearing. None support testifying to such opinions before a jury. *See Medrad, Inc.*

8 *v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005) ("The record in the instant case

9 makes it clear that the district court's construction was correct."); *Nazomi Commc'ns, Inc. v. Arm*

10 *Holdings, PLC*, 403 F.3d 1364, 1369 (Fed. Cir. 2005) ("To reach a proper construction, the

11 district court must look first to the claims, the specification, and the prosecution history, and if

12 further guidance is needed, to extrinsic evidence, such as dictionaries and expert opinions."); *V-*

13 *Formation, Inc. v. Benetton Grp. SpA*, 401 F.3d 1307, 1308 (Fed. Cir. 2005) ("[T]he district

14 court correctly construed the '466 patent's claim term.").

15   Freescale's argument that Dr. Vahid has employed accepted claim construction principles

16 (Freescale Opp. at 24-25) thus concedes that Dr. Vahid is: (1) construing claim terms (not

17 applying plain meaning); (2) doing so long after the Patent L.R. 4 deadline; and (3) doing so for

18 the impermissible purpose of arguing claim construction to the jury.

19   **2.**   **"interconnecting a plurality of components . . . in a predetermined**

20   **way" ('753 patent, claim 2)**

21   Freescale concedes that Dr. Vahid fails to use the plain and ordinary meaning of the term

22 "interconnecting a plurality of components ... in a predetermined way."   (Freescale Opp. at 5-6.)

23 There is no dispute that the Court did not construe this term in the '753 patent, and in fact

24 ordered that the "interconnecting" term requires no construction. (Dkt. No. 127 at 28.) Thus, the

25 plain and ordinary meaning should apply. Yet Freescale admits that, instead of applying the

26 plain and ordinary meaning, Dr. Vahid substitutes his own construction based on the meaning the

27 Court gave to "predetermined" in a different patent with claims directed to a different invention

28 based on a completely different specification. (Freescale Opp. at 6.) Dr. Vahid's use of the

1 Court's construction of "predetermined" from the U.S. Patent No. 6,311,244 (the "'244 patent")

2 is improper.

3 Citing *Aventis Pharms., Inc. v. Amino Chems. Ltd*., 715 F.3d 1363, 1380 (Fed. Cir. 2013),

4 Freescale argues that the term "predetermined" in the '753 patent should be given the same

5 meaning as in the '244 patent. (Freescale Opp. at 6.) What Freescale cites, however, is the

6 ***dissent*** in *Aventis*. The *Aventis* court actually held that the district court's construction was in

7 error because the lower court's reliance upon the related patent was "of little help" and there was

8 "no justification" for applying the definition of the term "substantially pure" from a related

9 patent to the term "substantially pure regioisomer" in the patent-at-issue. *Aventis*, 715 F.3d at

10 1375-76. Here there is no justification at all because the '244 patent is directed to a completely

11 different invention, based on a totally different specification.

3. "portion of the available bandwidth" ('845 patent, claim 21)

12 Freescale's argument regarding "portion of the available bandwidth" once again concedes

13 that Dr. Vahid performed a claim construction analysis rather than apply the plain and ordinary

14 meaning of the words. During his deposition, Dr. Vahid testified regarding the plain meaning of

15 "portion," but in his expert report he proposes a narrowing construction that limits the term to

16 embodiments disclosed in the specification and provisional application. (MediaTek Mot. at 8.)

17 Freescale argues that, when Dr. Vahid testified in deposition that the word "portion" could mean

18 "any or all," he was not talking about the meaning of the term "in the context of the '845 patent."

19 (Freescale Opp. at 7.) In other words, Freescale acknowledges that the plain meaning of

20 "portion" includes "any or all," and that Dr. Vahid is using the '845 patent's specification and

21 prosecution history to import a different, more narrow meaning of the term. Specifically, instead

22 of "any or all," Dr. Vahid proposes to offer a different construction of this term to the jury based

23 on two pages-worth of analysis of the specification and the provisional application in his report.

24 (Vahid Rebuttal Report at ¶¶ 155-163.) These opinions should be stricken. (*See* MediaTek Mot.

25 at 7-8, 21-23.)

4. "coupled" ('845 patent, claim 1)

26 Dr. Vahid proposes to testify to the jury that "coupled" requires a "direct" connection and

27 excludes an indirect connection with intervening components. (MediaTek Mot. at 8-10.)

28

1 Freescale cites to Dr. Vahid's discussion of the i.MX6SL product in paragraph 269 of Dr.

2 Vahid's rebuttal report and argues that Dr. Vahid applied the plain and ordinary meaning of

3 "coupled" as "communicate with" or requiring either an "electrical connection" or a "direct

4 transfer of information." (Freescale Opp. at 7.) However, Freescale omits paragraph 274 where

5 Dr. Vahid states: "As I laid out in my non-infringement analysis of the '845 patent with respect

6 to the i.MX6 DQ and i.MX6SDL, the specification and provisional application require that a

7 single bus is coupled to each master subsystem and both arbitration units." (Vahid Rebuttal

8 Report at ¶ 274.) In Dr. Vahid's analysis of the other i.MX6DQ and i.MX6SDL products, he

9 performs a claim construction analysis and defines "coupled to" as "connected to" based on his

10 examination of the provisional application and an embodiment in the specification. (*See* Vahid

11 Rebuttal Report at ¶¶ 229-230; MediaTek Mot. at 9-10.) Dr. Vahid's impermissible claim

12 construction should be stricken.

13   **5.   "DMA subsystem is configured and arranged such that, when the first
               and second arbitration units enables the DMA subsystem to access
14   each of the first and second slave subsystems, the DMA controller can
               cause data to be transferred between the first slave subsystem and the
15   second slave subsystem" ('845 patent, claim 1**)

16   In his rebuttal report, Dr. Vahid proposes to testify to the jury that this term "imposes a

17 temporal requirement on the claimed DMA transfer." (Vahid Rebuttal Report at ¶ 234, 280; *see*

18 *also* MediaTek Mot. at 10.) Rather than apply the plain and ordinary meaning of the term, Dr.

19 Vahid construes the term to require that the first and second arbitration units must enable the

20 DMA subsystem to access both slave subsystems at the same time. (Vahid Rebuttal Report at ¶

21 234; MediaTek Mot. at 10-11.) Dr. Vahid then argues that the accused products do not infringe

22 because the accused arbitration units do not enable the DMA subsystem "to access both the

23 [slave subsystems] before and *then maintain access* during a DMA data transfer between the

24 [slave subsystems]." (Vahid Rebuttal Report at ¶ 235 (emphasis added); *see also* MediaTek

25 Mot. at 10-11.)   But during his deposition, Dr. Vahid conceded that an embodiment of the '845

26 patent allowed for a DMA transfer to occur across multiple memory cycles. (*See* MediaTek

27 Mot. at 11-12.) Dr. Vahid thus conceded, in other words, that his construction excludes

28 disclosed embodiments. *See Accent Packaging, Inc. v. Leggett & Platt, Inc.*, 707 F.3d 1318,

1   1326 (Fed. Cir. 2013) ("a claim interpretation that excludes a preferred embodiment from the

2   scope of the claim is rarely, if ever, correct.") (quoting *On–Line Techs., Inc. v. Bodenseewerk*

3   *Perkin–Elmer GmbH*, 386 F.3d 1133, 1138 (Fed. Cir. 2004)).

4   　　　Realizing that Dr. Vahid's original opinion in his rebuttal report was incorrect based on

5   his deposition testimony, Freescale opposition now contends that MediaTek has misread Dr.

6   Vahid's opinion, and attempts to revise this opinion contrary to the express terms of his report.

7   Specifically, Freescale now argues that Dr. Vahid does not require that the DMA subsystem

8   access both first and second slave subsystems at the same time and in a single transaction.

9   (Freescale Opp. at 8.) However, Freescale then concedes that Dr. Vahid has construed the term

10 to require this "temporal requirement," arguing that Dr. Vahid's opinion is that the DMA

11 subsystem can only access "both slave subsystems across multiple memory cycles *so long as*

12 *both* the first and second arbitration units have granted access." (*Id.*) In other words, according

13 to Freescale, Dr. Vahid construes the claim term to require that the DMA subsystem must have

14 access to both slave subsystems at the same time. Dr. Vahid should be precluded from offering

15 any of Freescale's various claim construction opinions regarding this term to the jury.

6.　　"information indicating the clock frequency requirement" ('331 patent, claim 11)

17 　　　Freescale's argument for this term (Freescale Opp. at 8-9) demonstrates only that Dr.

18 Vahid performed an improper claim construction analysis. In his rebuttal report, Dr. Vahid

19 proposes to offer a construction to the jury for this term based on his analysis of the patent

20 specification and specific embodiments. (MediaTek Mot. at 12-13.) Freescale points to these

21 disclosures in the patent specification (*i.e.* intrinsic evidence) and explains that Dr. Vahid relied

22 upon them to define "information indicating the clock frequency requirement" of the '331 patent.

23 (*Id.*) This is a tacit admission that Dr. Vahid did not use commonly understood meanings of the

24 words of this claim term. Rather, he relied on intrinsic evidence to construe the term. Dr.

25 Vahid's improper claim construction opinions should be stricken.

7.　　"controller" ('331 patent, claims 11 and 35)

27 　　　Freescale does not deny that Dr. Vahid has performed an improper claim construction

28 analysis for the term "controller" in the '331 patent. In his rebuttal report, Dr. Vahid examines

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1   the provisional application, specification, and inventor testimony to form his claim construction

2   opinion that limits the "controller" to exclude implementations in software. Freescale's

3   opposition does not deny that Dr. Vahid construes the term. Instead, Freescale acknowledges

4   that Dr. Vahid has not applied the plain and ordinary meaning, by quoting portions of Dr.

5   Vahid's report where he relies on the '331 specification to assign a narrowing construction for

6   the term "controller." (Freescale Mot. at 9-10.)

7   In its opening brief, MediaTek cites to Magistrate Corley's order which makes clear that

8   Dr. Vahid's construction contradicts the plain meaning of the claim language. (MediaTek Mot.

9   at 13.) Freescale responds to this by arguing that "Judge Corley, however, was not asked to

10 make substantive claim construction findings . . . and did not strike any proposed constructions

11 from this case." (Freescale Opp. at 10.) In other words, Freescale argues that Dr. Vahid should

12 be permitted to construe the term "controller." As such, Freescale's opposition appears to

13 concede that Dr. Vahid purports to construe the term "controller" to the jury rather than apply the

14 plain and ordinary meaning.

8.   "same priority" ('845 patent, claim 21)

16 Rather than apply the plain and ordinary meaning of this term, Dr. Vahid construes this to

17 mean that "same priority" in claim 21 "must refer to a property associated with the request at the

18 time the request in generated." (MediaTek Mot. at 15.) In its opposition, Freescale does not

19 contend that Dr. Vahid is applying the claim language to an accused product or prior art.

20 Instead, Freescale summarizes Dr. Vahid's construction of the claim and then attacks MediaTek

21 for not providing support for the plain and ordinary meaning of "same priority." (Freescale Opp.

22 at 10-11.) However, the plain and ordinary meaning of a term is simply "the application of the

23 widely accepted meaning of commonly understood words." *Phillips*, 415 F.3d at 1314. Dr.

24 Vahid should not be permitted to vary the plain meaning of "same priority" by resorting to

25 specification and prosecution history arguments.

9.   "to determine a clock frequency requirement" ('331 patent, claim 35)

26 Freescale's argument for this term is inconsistent. First, Freescale cites Dr. Vahid's self-

27 serving statement that he is merely applying the Court's construction. (Freescale Opp. at 11.)

28 But despite claiming to apply the Court's construction, Dr. Vahid proceeds to create his own

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1 definition for the term. (MediaTek Mot. at 17.) Freescale then argues that because the Court's

2 construction was based on a definition that Freescale proposed, Dr. Vahid somehow has license

3 to narrow the meaning of this term through further construction. (Freescale Opp. at 11.) Finally,

4 Freescale reverts to contending that Dr. Vahid's new construction of "determine" is not a

5 construction at all, but is instead merely a discussion of how the specification provides an

6 adequate written description of the term.

7 Freescale's argument has no merit. Freescale cannot avoid the fact that: (1) Dr. Vahid

8 expressly states that, irrespective of the Court's construction, the word "determine" also

9 "requires [that] the DPC actively processes information from the monitored processor(s) to arrive

10 at the clock frequency requirement"; (2) Dr. Vahid makes this contention in a section of his

11 report titled "Claim Construction of 'to determine a clock frequency requirement'"; and (3) the

12 Court's construction of determine ("ascertain by observation") is different than Dr. Vahid's

13 construction ("actively processes information"). (*See* Vahid Opening Report at ¶ 184; Freescale

14 Opp. at 17.)

15 Not only does Dr. Vahid propose to argue a different construction of "determine" to the

16 jury from what the Court has ordered, Dr. Vahid's proposed construction violates basic

17 principles of claim construction law by departing from the plain and ordinary meaning, limiting

18 the scope of the claims to a disclosed embodiment, importing limitations from the specification,

19 and excluding disclosed embodiments. (*See* MediaTek Mot. at 19-25.)

20 **C. Contrary to Freescale's Assertion, Dr. Vahid Does Not Use the Same Method or Offer the Same Types of Opinions as MediaTek's Experts**

21 Freescale attempts to excuse its untimely introduction of claim construction arguments by

22 stating that "MediaTek withheld the bulk of the claim construction positions set forth above until

23 expert discovery." (Freescale Opp. at 20.) Freescale suggests that MediaTek's experts used the

24 same methodology and performed the same type of claim construction that Dr. Vahid does.

25 (Freescale Opp. at 13-15.) Freescale is wrong. Freescale has not identified a single example of

26 one of MediaTek's experts providing a "construction" of a claim term, *i.e.* opinion on how

27 specification, prosecution history, cited prior art or extrinsic evidence alter the scope of a claim

28 term. Instead, MediaTek's experts uniformly apply the plain and ordinary meaning of each term

1   -- the ordinary meaning that is "readily apparent even to lay judges," involving "little more than

2   the application of the widely accepted meaning of commonly understood words." *Phillips*, 415

3   F.3d at 1314. Nowhere did Dr. Asanovic or Mr. Narad provide any opinions that any of the

4   claim terms should be interpreted in such a way that: (1) departed from the ordinary and

5   customary meaning; (2) imported limitations from the specification; (3) excluded disclosed

6   embodiments; or (4) ignored the Court's claim construction order. (*See, e.g.*, Freescale Opp. at

7   13-15.) Freescale's "everybody's doing it" argument has no merit.

8   **D.**   **The Court Should Reject Freescale's Request For a Second Round Of Claim Construction On The Eve Of Trial**

9   **1.**   **Freescale's Request is Untimely**

10   Pursuant to Patent L.R. 4, the Court ordered a detailed schedule for claim construction in

11   this case. During this Court-ordered claim construction process, Freescale never proposed that

12   any of the terms set forth in MediaTek's Opening Brief required construction. Freescale then

13   waited until its Rebuttal Expert Report to provide detailed opinions from its expert regarding the

14   specific constructions of multiple terms from each of the asserted patents. The Court set forth an

15   orderly process for the exchange of claim terms, proposed constructions, briefing, and a hearing

16   on claim construction. It is improper for Freescale to remain silent during the discovery period

17   only to ambush MediaTek with its claim constructions after the close of fact discovery. Patent

18   L.R. Rule 4 exists to prohibit such unfair tactics.

19   According to Freescale, if Dr. Vahid has provided claim construction opinions, then it is

20   not necessary to exclude his opinions, but instead the Court has a duty to resolve the claim

21   construction dispute. (Freescale Mot. at 15-16.) Freescale's proposal that the Court address its

22   new substantive claim construction arguments now (1) is flatly inconsistent with its position that

23   Dr. Vahid's constructions are nothing more than the "plain and ordinary" meaning of the terms,

24   and (2) would severely prejudice MediaTek. Holding another *Markman* hearing at this late stage

25   after fact and expert discovery have been closed for months, and when MediaTek is unable to go

26   back and re-take discovery on other positions under Freescale's new constructions, would throw

27   any sense of fairness to MediaTek out the window. For this reason alone, Freescale's request to

28   re-open the claim construction process for the nine new terms should be rejected. *See e.g.,*

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1   *ActiveVideo*, 694 F.3d at 1326 ("The district court did not err in concluding that these terms have

2   plain meanings that do not require additional construction… It was up to the jury to determine

3   from the evidence presented at trial whether the ActiveVideo system satisfied the plain and

4   ordinary meaning of the 'superimposing' limitations. We affirm the district court's denial of

5   ActiveVideo's JMOL of non-infringement for the '214 patent.").

6   　　　　　　　　　**2.　　　Dr. Vahid's Proposed Claim Constructions Violate Basic Canons of
       Claim Construction Law**

7   　　　　Finally, the Court should refuse Freescale's untimely request for a supplemental claim

8   construction process for the additional reason that the constructions proposed by Dr. Vahid are

9   unreliable and incorrect on their face. As set forth in MediaTek's Opening Brief, Dr. Vahid's

10 claim construction opinions violate basic canons of claim construction law. Dr. Vahid's

11 proposed constructions would contradict the plain and ordinary meaning of the claim terms

12 (MediaTek Mot. at 21-22), import limitations from the specifications to improperly narrow the

13 scope of the claims (*Id.* at 22-23), and impermissibly exclude preferred embodiments. (*Id.* at 23-

14 24.) Accordingly, wholly apart from the severe prejudice that the grant of Freescale's improper

15 and untimely request for an eve-of-trial supplemental claim construction process would impose

16 on MediaTek, Freescale's request should be rejected for the additional reason that the new

17 constructions Freescale seeks on their face improperly conflict with the plain and ordinary

18 meanings of the claim terms.

19 **III.　　CONCLUSION**

20 　　　　For all of the reasons above, as well as for those presented in MediaTek's original

21 motion, MediaTek respectfully requests that this Court grant its motion to strike, or in the

22 alternative preclude under *Daubert*, Dr. Vahid's improper claim construction opinions.

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Respectfully submitted,
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By their attorneys,

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